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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/596,857	06/19/2000	THOMAS A BERSON	XER1P015	4200

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EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT PAPER NUMBER

3621

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/596,857

Applicant(s)

BERSON ET AL.

Examiner

Mary Cheung

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 27 December 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of the Claims

1. Claims 1-24 are pending. Claims 1-5, 8-13, 15-19 and 22-24 have been amended.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5, 9, 11-13, 15-19 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamamoto, U. S. Patent 6,078,663.

As to claim 1, Yamamoto teaches a method for pricing a cryptographic service on a network utilizing one or more cryptoservers, comprising (abstract):

(a) Receiving a request for the cryptographic service from a user utilizing the network, wherein the request is received by a cryptographic service provider (column 16 lines 20-22, 42-67);

(b) Generating a contract based on a variable pricing scheme in response to the request (column 16 lines 23-31);

(c) Sending the contract from the cryptographic service provider to the user utilizing the network (column 16 lines 23-41).

As to claim 2, Yamamoto teaches the cryptographic service provider selects one of the one or more cryptoservers to perform the cryptographic service (column 4 lines 14-21 and column 37 lines 39-48 and Fig. 42).

As to claim 3, the cryptographic service provider is a commercial service compete for customers is taught by Yamamoto as the plurality of cryptoservers are commercial services, each cryptoserver provides different feature to meet customer's best interest (column 37 line 39 – column 38 line 63 and Fig. 42).

As to claim 4, Yamamoto teaches the one or more cryptoservers is part of a single distributed service (Fig. 42).

As to claim 5, Yamamoto teaches the variable pricing scheme is based on at least one of: a data load of the one or more cryptoservers during performance of the cryptographic service, a distance between the one or more cryptoservers and the user, a congestion of the network during performance of the cryptographic service, and a rating of the one or more cryptoservers performing the cryptographic service (column 2 lines 44-53 and column 3 line 55 – column 4 line 4 and column 11 line 45-59 and column 55 lines 25-28).

As to claim 9, Yamamoto teaches the cryptographic service provider is a one of the one or more cryptoservers (abstract and Figs. 4, 11).

Claims 11-13, 15-19 and 23 are rejected for the similar reasons as claims 1-5 and 9.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 6-8, 14, 20-22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto, U. S. Patent 6,078,663 in view of Coyle, U. S. Patent 6,269,157.

As to claims 6-8, Yamamoto teaches variable pricing scheme for cryptographic service as discussed above. As to claim 24, Yamamoto teaches the cryptographic service is conducted securely as a cryptographic protocol by one or more cryptoserver (column 3 lines 55-58 and Fig. 9). As to claims 6-8 and 24, Yamamoto does not specifically teach the variable pricing scheme is auction-based. However, Coyle teaches providing an auction for bidding on telecommunication service (abstract and

column 9 lines 14-16 and Fig. 26). It would have been obvious to one of ordinary skill in the art at the time of the invention to allow the variable pricing scheme of Yamamoto to be auction-based as taught by Coyle because it would allow user of Yamamoto to bargain for the best price on cryptographic service.

Claims 14 and 20-22 are rejected for the similar reasons as claims 6-8.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto, U. S. Patent 6,078,663 in view of Schneier et al., U. S. Patent 5,956,404.

As to claim 10, Yamamoto teaches the cryptographic service provider provides a receipt upon performing the cryptographic service, wherein the receipt includes the time and duration of the computations, a description of the computation and the identities of the one or more cryptoservers and the customer (column 1 line 26-32 and column 8 line 65 – column 9 line 23 and Figs. 39-42, 46-49). Yamamoto does not explicitly teach the receipt includes at least one of one-way hash of the results of its computations.

However, Schneier teaches using well-known one-way hash for securely transmit information (abstract and column 1 line 66 – column 2 line 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the well-known one-way hash function in the method of Yamamoto for securely providing the cryptographic service.

Response to Arguments

8. Applicant's arguments filed 12/27/2002 have been fully considered but they are not persuasive.

In response to applicant's arguments for claim 1 that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the user is requesting pricing from a cryptographic server, the cryptographic service provider offering the cryptographic service desired by the user for a price) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that Yamamoto fails to teach the cryptographic service provider is a commercial service compete for customers, Yamamoto teaches this matter by allowing each cryptoserver to provide different features to meet customer's best interest. The ultimate goal of doing this is to encourage or attract customers to use Yamamoto's service rather than other competitors' services.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

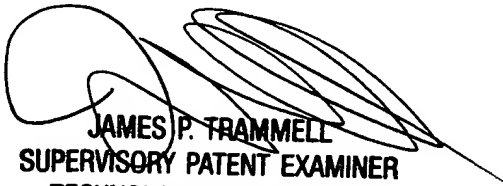
The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 305-7687 (Official Communications; including After Final
Communications labeled "BOX AF")

(703) 746-5619 (Draft Communications)

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7th Floor Receptionist.

Mary Cheung
Patent Examiner
Art Unit 3621
March 8, 2003


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